

Response under 37 C.F.R. 1.116

Applicant: Sterling Mortensen

Serial No.: 09/941,467

Filed: August 29, 2001

Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

REMARKS

The following Remarks are made in response to the Final Office Action mailed May 4, 2005 and the Advisory Action mailed July 22, 2005. Claims 1-10, 14-25, and 28-30 are rejected, and claims 11-13 and 26-27 are allowed. Claims 1-30 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103

Claims 1-3, 14-20, 22, and 28-30 are rejected under 35 U.S.C. 102(e) as being unpatentable over McCurdy et al. US 2002/0035697. Claims 4-10 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCurdy et al. US 2002/0035697 in view of Beale, "Get Prepress-Ready PDFs from QuarkXPress".

McCurdy et al. has a publication date of March 21, 2002 and a filing date of July 2, 2001. In addition, the "Related U.S. Application Data" of the McCurdy et al. U.S. Patent Application identifies the application as a Non-Provisional of Provisional Application No. 60/215,683, filed on June 30, 2000.

Accompanying this Response is a Revised Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 30, 2000 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from just prior to the earliest effective date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice). Applicant, therefore, respectfully requests consideration of the Revised Declaration of Prior Invention under 37 C.F.R. 1.131.

In view of the above, Applicant submits that McCurdy et al. does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a). Applicant, therefore, respectfully requests that the rejection of claims 1-3, 14-20, 22, and 28-30 under 35 U.S.C. 102(e) and the rejection of claims 4-10, 21, 23, and 24-25 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-30 be allowed.

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Allowable Subject Matter

Claims 11-13 and 26-27 are objected to as being dependent upon a rejected base claim and are indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicant agrees with the Examiner that claims 11-13 and 26-27 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. As outlined above, Applicant, however, has submitted a Revised Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 30, 2000 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from just prior to the earliest effective date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice). Applicant, therefore, respectfully requests that the objection to claims 11-13 and 26-27 be withdrawn and that claims 11-13 and 26-27 be allowed.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-30 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

Sterling Mortensen,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of August, 2005.

By 

Name: Scott A. Lund